

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
Ex parte Emerling et al.
Appeal No. _____**

Serial No.: 10/711,457
Filed: September 20, 2004
Art Unit: 3612
Examiner: Gregory A. Blankenship
Applicant: David M. Emerling
Title: MOLDED AUTOMOBILE VISOR
Attorney Docket: MASLIAC-51
Confirmation No.: 5456

Cincinnati, Ohio 45202

February 8, 2008

Commissioner for Patents
P. O. Box 1450
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BRIEF ON APPEAL

This brief is in furtherance of Appellants' Notice of Appeal filed November 28, 2007, appealing the decision of the Examiner dated August 28, 2007, rejecting claims 1-18 (all pending claims). A copy of the claims appears in the Claims Appendix to this brief.

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I. Real Party in Interest

The real party in interest is International Automotive Components Group North America, Inc., of Dearborn, Michigan, which is the assignee of the present invention.

II. Related Appeals and Interferences

An Appeal Brief and a Reply Brief were filed in related U.S. Patent Application Serial No. 10/708,312 on August 27, 2007, and December 27, 2007, respectively. That appeal is pending.

III. Status of Claims

Claims 1-18 remain pending in the application after the rejection dated August 28, 2007, and are subject to this appeal. Claims 1-6, 10-13, and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,840,561 to Mills et al. in view of U.S. Patent Application Publication No. 2003/0184064 to Hier et al. Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Mills '561 and Heir '064, in further view of Great Britain Patent No. 2,336,577 to Fischer et al.

Claims 8, 9, 14, 15, 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Mills '561 and Heir '064, in further view of U.S. Patent No. 5,720,509 to Binish.

IV. Status of Amendments

There are no amendments pending after the rejection dated August 28, 2007.

V. Summary of Claimed Subject Matter

Claims 1, 10, and 16 are independent claims. Below, Appellants have provided a summary of the claim language mapped to the supporting disclosure of an exemplary embodiment for representation purposes only.

Claim 1 is directed to an automotive visor 12 that can be movably secured to an automobile 10, as is shown in FIG. 1. The automotive visor 12 includes a core member 24 having an outer surface (Application at paragraph 17, line 5, and FIG. 2A) and a polymeric cover layer 26 integrally formed in place onto the outer surface of the core member 24. (Application at paragraph 18, line 1; at paragraph 19, lines 3-4; and FIG. 2A.) The visor 12 further includes a support arm 20 coupled to the core member 24 and adapted to mount the visor 12 proximate a windshield of an automobile 10 (Application at paragraph 16, lines 7-8; and at paragraph 19, lines 6-7).

Claim 10 is directed to a method of forming an automotive visor 12 including forming a visor core 24 from a polymeric material having a first hardness (Application at paragraph 18, lines 3-5) and integrally forming a cover layer 26 in place on an outer surface of the visor core 24 (application at paragraph 18, line 1). The cover layer 26 comprising polymeric material having a second hardness relatively lower than the first hardness. (Application at paragraph 18, lines 3-5.) The method further includes coupling a support arm 20 to the visor core 24, the support arm 20 is adapted to mount the visor 12 proximate a windshield 18 of an automobile 10. (Application at paragraph 19, lines 6-7, and FIG. 1.)

Claim 16 is directed to a method of forming an automotive visor 12 including providing a visor core 24 (Application at paragraph 17, line 5), integrally forming a

polymeric cover layer 26 in place on an outer surface of the visor core 24 (Application at paragraph 18, line 1), and coupling a support arm 20 to the visor core 24 (Application at paragraph 19, lines 5-6). The support arm 20 is adapted to mount the visor 12 proximate a windshield 18 of an automobile 10 (Application at paragraph 16, lines 5-9).

VI. Grounds of Rejection to be Reviewed on Appeal

A. The rejections of claims 1-6, 10-13, and 16 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,840,561 to Mills et al. in view of U.S. Publication No. 2003/0184064 to Hier et al.

B. The rejection of claim 7 under 35 U.S.C. §103(a) as being obvious over the combination of Mills '561 in view of Hier '064 in further view of Great Britain Patent No. 2,336,577 to Fischer et al.

C. The rejections of claims 8, 9, 14, 15, 17, and 18 under 35 U.S.C. §103(a) as being obvious over the combination of Mills '561 in view of Hier '064 in further view of U.S. Patent No. 5,720,509 to Binish.

VII. Argument

A. The Rejections of claims 1-6, 10-13, and 16 Under 35 U.S.C. §103(a)

Claims 1-6, 10-13, and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent No. 6,840,561 to Mills et al. in view of U.S. Patent Application Publication No. 2003/0184064 to Hier et al.

Claims 1, 10, and 16 are the only independent claims of this rejected group. Independent claim 1 is directed to an automotive visor comprising "a polymeric cover

layer integrally formed in place onto said outer surface of said core member."

Independent claims 10 and 16 are directed to methods of forming an automotive visor and each recites "integrally forming a cover layer in place on an outer surface of the visor core." The rejections of claims 1, 10, and 16 should be reversed because the Examiner fails to establish some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Mills '561 or to combine Mills '561 and Hier '064.

A claim is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. KSR Int'l Co. v. Teleflex, Inc., 82 USPQ2d 1385 (2007). "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex, Inc., 82 USPQ2d 1385 (2007), citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). When presenting a line of reasoning "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." KSR Int'l Co. v. Teleflex, Inc., 82 USPQ2d 1385 (2007). In addition, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992).

Mills '561 is directed to an automotive visor comprising a core 12 and a separate cover material 14 made of fabric. Mills '561 utilizes foldable core halves to secure the separate fabric cover to the visor. The core has a clamshell configuration with first and second core halves 20, 22 that are folded about a living hinge 24 (Mills '561 at col. 3,

lines 43-46). The cover material 14 is secured to the core 12 by wrapping the cover material 14 around the peripheral lips 60, 62 of each core half 20, 22 and folding the core halves 20, 22 about the living hinge 24 to capture the edges 58 of the cover material 14 between the core halves 20, 22. (Mills '561 at col. 4, lines 1-29.)

It is undisputed that Mills '561 does not disclose each and every claimed element as the Examiner admits that Mills '561 fails to disclose a polymeric cover layer integrally formed in place on an outer surface of a core member. (See final Office Action at page 3.) The Examiner asserts that Hier '064 teaches "a polymeric cover layer integrally formed in place." (See final Office Action at page 3.)

Hier '064 is directed to a vehicle instrument panel comprising a retainer portion 12 having an opening 20 defining a void over an airbag 16. A door 14 is formed over the opening 20 through which the airbag 16 may be deployed. Hier '064 discloses the instrument panel as having a seamless door integrated therein for deploying the airbag. Consequently, Hier '064 is concerned with hiding seams in a molded instrument panel where an airbag will be deployed.

Mills '561 and Hier '064 do not expressly or impliedly suggest the claimed combination. The Examiner admits that Hier '064 fails to disclose replacing a fabric cover layer with a polymeric cover layer that is molded in place. (See final Office Action at page 4.) Moreover, none of the remaining references of record disclose replacing a fabric cover layer with a polymeric cover layer that is molded in place.

In light of the admitted and noted failures in the references, the Examiner then fails to present a convincing line of reasoning as to why one skilled in the art would have found the claimed invention obvious. The Examiner alleges that it would have been

obvious to "cover the core member of Mills '561 with a formed in place polymeric cover layer, as taught by Hier '064, in place of the cover layer of Mills '561 to provide a seamless cover that requires less steps to manufacture." (See non-final Office Action mailed April 13, 2007, at page 3.) While Appellants do not admit that Hier '561 discloses a "formed in place polymeric cover layer" as the Examiner alleges, the Examiner's alleged motivation for combining Mills '561 and Hier '064 fails because, even if a polymeric cover layer were applied to the core 12 of Mills '561, the clamshell configuration of Mills '561 still requires that the core halves 20, 22 to be folded about the living hinge 24 to form the visor. Thus, the Examiner's construction would not result in a seamless cover. In response to Appellants' argument that the Examiner's alleged combination of Mills '561 and Hier '064 would not result in a seamless cover, the Examiner argues that a polymeric cover could be molded onto the core of Mills '561 after the core is folded. (See final Office Action at page 5.)

The Examiner's rationale is, however, contrary to the teaching of Mills '561. Specifically, as described above, Mills '561 teaches a visor core having a clamshell configuration so that cover material may be wrapped over the core, and then the core may be folded to secure the edges of the cover material between the core halves. Accordingly, persons skilled in the art would not have been motivated to first fold the core, then replace the fabric cover material of Mills '561 with a polymeric cover to obtain a seamless cover, as alleged by the Examiner. In rejecting claims 1, 10, and 16 based on Mills '561 in view of Hier '064, the Examiner takes a mental leap that is contrary to the teaching of Mills '561 and is not supported by the references of record. For at least these reasons, Appellants assert that the Examiner has failed to present a *prima facie*

case of obviousness in rejecting claims 1, 10, and 16, and respectfully request that the rejections of claims 1, 10, and 16 be reversed.

Claims 2-6 each depend directly or indirectly from independent claim 1, and claims 11-13 each depend from independent claim 10. Accordingly, the rejections of claims 2-6 and 11-13 should be reversed for least the reasons discussed above with respect to their respective independent claims 1 and 10.

B. The Rejections of claim 7 Under 35 U.S.C. §103(a)

Claim 7 stands rejected under U.S.C. §103(a) as being unpatentable over the combination of Mills '561 and Hier '064 in further view of UK Patent Application GB 2,336,577 to Fischer et al. Claim 7 depends from claim 1.

Mills '561 admittedly fails to teach or suggest the combination of elements recited in claim 1, including a polymeric cover layer integrally formed in place onto said outer surface of said core member, as discussed above. The Examiner fails to establish a reason to modify Mills '561 or combine Mills '561 with Hier '064. Fischer '577 does not expressly or impliedly suggest the alleged combination of Mills '561 and Hier '064. Moreover, Fischer '577 does not disclose a polymeric cover layer wherein the cover layer is textured to simulate fabric material, as recited in claim 7. Rather, Fischer '577 is directed to an automotive visor wherein an exterior fabric material 54 is positioned in a mold cavity 124 and polymeric beads are then introduced into the mold cavity so that the cover fabric 54 is bonded to the polymeric material. Fischer '577 therefore does not disclose replacing a fabric cover material of Mills '561 with a polymeric cover layer that is

integrally formed in place on the outer surface of a core member. For at least these additional reasons, the rejection of claim 7 should be reversed.

C. The Rejections of claims 8, 9, 14, 15, 17, and 18 Under 35 U.S.C.

§103(a)

Claims 8, 9, 14, 15, 17, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Mills '561 and Hier '064 in further view of U.S. Patent No. 5,720,509 to Binish. Each of these claims is a dependent claim directed to a visor having an accessory affixed to the core member and integrally molded with the cover layer, or a method of making a visor including integrally molding an accessory with the cover layer.

Binish '509 does not cure the deficiencies of the Examiner's *prima facie* case as discussed above. Binish '509 is directed to an automotive visor formed by placing a fabric cover and accessory into a mold and then injecting a polymeric material into the mold to form the core. In addition to the legal deficiencies discussed above with respect to claims 1, 10, and 16, the rejections of claims 8, 9, 14, 15, 17, and 18 are clearly legally deficient because the fabric cover and accessory of Binish '509 are placed into the mold, and then foam material is injected into the center of the fabric so that the foam expands to form lips over the accessory. Thus, Binish '509 fails to disclose an integrally formed in place polymeric cover that affixes accessories to a core member of a visor, as recited in claims 8, 9, 14, 15, 17, and 18. For at least these additional reasons, Appellants respectfully request that the rejections of claims 8, 9, 14, 15, 17, and 18 be reversed.

Conclusion

For the reasons stated above, Appellants respectfully urge the Board to reverse the rejections of claims 1-18.

If there are any questions regarding the foregoing, please contact the undersigned at 513/241-2324. If any charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

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VIII. Claims Appendix

1. (PREVIOUSLY PRESENTED) An automotive visor, comprising:
a core member having an outer surface;
a polymeric cover layer integrally formed in place onto said outer surface of said core member; and
a support arm coupled to said core member and adapted to mount the visor proximate a windshield of an automobile.
2. (ORIGINAL) The visor of claim 1, wherein said core member is formed from polymeric material having a hardness that is relatively higher than a hardness of said cover layer.
3. (ORIGINAL) The visor of claim 1, wherein said core member comprises first and second sections joined together in a confronting arrangement.
4. (ORIGINAL) The visor of claim 3, wherein said first and second sections are hingedly coupled together for folding toward said confronting arrangement.
5. (ORIGINAL) The visor of claim 1, wherein said cover layer substantially encapsulates said core member.
6. (ORIGINAL) The visor of claim 1, wherein said cover layer is integrally molded on selected areas of said outer surface.

7. (ORIGINAL) The visor of claim 1, wherein said cover layer is textured to simulate fabric material.

8. (ORIGINAL) The visor of claim 1, further comprising an accessory affixed to said core member and integrally molded with said cover layer.

9. (ORIGINAL) The visor of claim 8, wherein said accessory is a mirror.

10. (PREVIOUSLY PRESENTED A method of forming an automotive visor, comprising:

forming a visor core from a polymeric material having a first hardness;

integrally forming a cover layer in place on an outer surface of the visor core, the cover layer comprising polymeric material having a second hardness relatively lower than the first hardness; and

coupling a support arm to the visor core, the support arm adapted to mount the visor proximate a windshield of an automobile.

11. (ORIGINAL) The method of claim 10, wherein forming the visor core further comprises:

forming first and second core sections, each core section having an inner surface;

arranging the first and second core sections such that the inner surfaces face one another in a confronting relationship; and

securing the first and second core sections together.

12. (ORIGINAL) The method of claim 10, wherein forming the cover layer further comprises substantially encapsulating the visor core.

13. (PREVIOUSLY PRESENTED) The method of claim 10, wherein integrally forming the cover layer further comprises applying polymeric material having the second hardness to selected areas of the outer surface.

14. (ORIGINAL) The method of claim 10, further comprising:
integrally molding an accessory onto the visor with the cover layer.

15. (ORIGINAL) The method of claim 14, wherein the accessory comprises a mirror.

16. (PREVIOUSLY PRESENTED) A method of forming an automotive visor, comprising:
providing a visor core;
integrally forming a polymeric cover layer in place on an outer surface of the visor core; and
coupling a support arm to the visor core, the support arm adapted to mount the visor proximate a windshield of an automobile.

17. (ORIGINAL) The method of claim 16, further comprising:

integrally molding an accessory onto the visor with the cover layer.

18. (ORIGINAL) The method of claim 17, wherein the accessory comprises a mirror.

IX. Evidence Appendix

There is no evidence submitted in this Appeal.

X. Related Proceedings Appendix

The present application is related to pending U.S. Patent Application Serial No. 10/708,312 filed on February 24, 2004.